DETAILED ACTION

Status of the Claims

Claims 1-13 are pending.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on 12/23/04, 06/13/05 and 06/20/05 respectively is acknowledged and have been entered into the file. Signed copies of the 1449 are attached herewith. Applicants should note that form 1449 did not accompany the I.D.S. filing of 06/13/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 8-9, recite the phrase " which forms an azeotrope or heteroazeotrope with water under the pressure and temperature conditions of the distillation mentioned below." However, none of claims 1-13 recite a distinct temperatures or pressures in the process rendering the claims indefinite. Additionally, the reference to "in the region" is indefinite because the use of the term "region" implies a location rather than a quantity. If applicants mean "amount", then the term should be used. Clarity in the language of claims to particularly point out what applicant intends regarding the term "region" would be favorably considered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,084,294. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is considerable overlap between the instantly claimed process and the process of 7,084,294. The current invention claims a process for the removal of water from a mixture comprising water and zinc chloride whereas '294' recites a process for the recovery of a Lewis acid from a reaction mixture which has been obtained in a hydrocyanation process. However, it is noted that the preferred Lewis acid mentioned in the specification of '294' is zinc chloride.

The instant invention differs from '294' in that the instant claims are drawn to the issued claims in a narrower scope, i.e., zinc chloride. Since zinc chloride is a Lewis acid, such preparation is deemed *prima facie* obvious. Note the process steps of current claim 1 is similar to the process steps of claim 1 of '294' i.e., an overlap of the use of diluents whose boiling point in the case where an azeotrope is formed or not formed between said diluents and water, with subsequent removal of water from the zinc chloride and water mixture.

Note the required pH of 0 to than 7 recited in instant claims 3, 4, 7 and 8 which overlaps with pH's of claims 6, 7 and 15 of '294'. Note claim 11 of '294' recites the same diluents recited in instant claim 1. With reference to weight percentages recited

in current claims 11-13, similar percentages are recited in claims 2, 3, 13 and 17 of '294'.

Thus, at the time of filing this application, the instantly claimed process would have been suggested to one of ordinary skill in the art since the use of similar reactants to yield the instant product is a predictable process and would result in the production of zinc chloride. The requisite motivation being the desire to prepare zinc chloride. The instantly claimed invention is nothing more than the extension of monopoly already granted on '294'.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS

/James O. Wilson/
Supervisory Patent Examiner
Art Unit 1624